



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,554	07/06/2001	Michael Millette	7056.038	5011

25546 7590 06/04/2007
DREIER & BARITZ LLP
499 PARK AVENUE
20TH FLOOR
NEW YORK, NY 10022

EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
----------	--------------

3692

MAIL DATE	DELIVERY MODE
-----------	---------------

06/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/900,554

Applicant(s)

MILLETTE ET AL.

Examiner

Nga B. Nguyen

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19, 21-29 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19, 21-29 and 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the communication filed on March 9, 2007, which paper has been placed of record in the file.
2. Claims 1-9, 11-19, 21-29, and 31-45 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-9, 11-19, 21-29, and 31-45 have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9, 11-19, 21-29, and 31-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite "a computer implement method" but the specification does not disclose any computer, machine or apparatus in order to performing the method claiming.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 11-19, 21-29, and 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, U.S. Patent No. 7,222,094.

Regarding to claim 1, Ross discloses a computer implemented method for structuring an equity issue comprising:

(a) establishing a holding company as an owner of a closed block business entity, wherein the holding company is a subsidiary of a parent company and further wherein an on-going business is a subsidiary of the parent company (column 3, lines 60-65, a holding company is a subsidiary of a parent company);

(b) representing the on-going business by a first class of stock issued from the parent company (column 3, lines 60-65, the stock may be the stock issuer by the parent company);

(c) issuing a second class of stock in the parent company, wherein the second class of common stock represents an ownership interest in the closed block business entity (column 3, lines 23-45, issuing a debt security)

(d) classifying proceeds received from the issuance of the second class of stock as assets of the on-going business (column 1, lines 47-column 2, line 40); and

(e) converting said second class of stock into said first class of stock (column 2, lines 1-5, 15-20, 28-33).

Ross does not disclose wherein the closed block business entity has a business growth and business margin that are less than the business growth and the business margin of the on-going business. However, wherein the closed block business entity has a business growth and business margin that are less than the business growth and the business margin of the on-going business. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ross's to incorporate the well-known feature above, for the purpose of comparing the business growth and the business margin between the holding company and the parent company in order to make investment decision.

Regarding to claim 4, Ross further discloses issuing debt from the holding company, wherein: the debt is issued for raising capital for the parent company and the capital is provided to the on-going business; and the debt is serviceable from the cash flow of the closed block business entity and the debt has limited recourse only to the closed block business entity (debt instrument itself is an financial instrument issued for the purpose of raising capital for a company).

Regarding to claims 7-9, Ross further discloses wherein said first class of stock is a common stock, said second class of stock is a common stock (column 16, lines 5-10). Ross does not disclose first class of stock is a preferred class of stock. However, investing a preferred stock is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify

Ross's to incorporate the well-known feature above, for the purpose of providing a preferred stock for investing.

Regarding to claims 11-14, Ross further discloses wherein said second class of stock is converted into said first class of stock at the discretion of the parent company, wherein said second class of stock is converted into said first class of stock at a premium conversion rate, wherein said second class of stock is converted into said first class of stock upon the occurrence of at least one of a merger, an acquisition, and a change of control, involving the parent company, wherein said second class of stock is converted into said first class of stock upon the expiration of a holding time period (columns 12-16).

Regarding to claims 15-16, Ross does not disclose wherein the parent company owns a 100% interest in the holding company, wherein the holding company owns a 100% interest in said closed block business entity. However, wherein the parent company owns a 100% interest in the holding company or wherein the holding company owns a 100% interest in said closed block business entity is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ross's to incorporate the well-known feature above, for the purpose of determining the percentage of owns interest in the holding company and parent company in order to make investment decision.

Regarding to claim 37, Ross does not disclose wherein closed block business entity is an insurance business entity selected from the group consisting of at least one of an insurance company, a mutual insurance company, and a mutual life insurance

company, an insurance business unit, a mutual insurance business unit, and a mutual life insurance business unit. However, those companies are well known in the art.

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ross's to incorporate the well-known feature above, for the purpose of allowing such company to issue a debt instrument for raising capital.

Claims 2, 5, 17-19, and 21-26 contain similar limitation found in claims 1, 4, 7-9, and 11-16 above, therefore, are rejected by the same rationale.

Claims 3, 6, 27-29, and 31-36 contain similar limitation found in claims 1, 4, 7-9, and 11-16 above, therefore, are rejected by the same rationale.

Claims 38 and 42 contain similar limitations found in claims (1, 7, 8) and 4 above, therefore, are rejected by the same rationale.

Claims 39 and 43 contain similar limitations found in claims (2, 17, 18) and 5 above, therefore, are rejected by the same rationale.

Claims 40 and 44 contain similar limitations found in claims (3, 27, 28) and 6 above, therefore, are rejected by the same rationale.

Claims 41 and 45 contain similar limitations found in claims (1, 7, 8) and 4 above, therefore, are rejected by the same rationale. Moreover, Ross does not disclose wherein the closed block business entity is in a traditionally risky or controversial business sector. However, wherein the closed block business entity is in a traditionally risky or controversial business sector is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ross's to incorporate the well-known feature above, for the purpose of

comparing the traditionally risky or controversial business sector of the holding company and the parent company in order to make investment decision.

Conclusion

8. Claims **1-9, 11-19, 21-29, and 31-45** are rejected.
9. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Sauter et al. (US 6,879,964) disclose an investment company that issues a class of conventional shares and a class of exchange-traded shares in the same fund.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
C/o Technology Center 3600
Washington, DC 20231

Art Unit: 3692

Or faxed to:

(703) 872-9306 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).

A handwritten signature in cursive script, appearing to read "Nga Nguyen".

NGA NGUYEN
PRIMARY EXAMINER

May 25, 2007